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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,320	08/15/2001	May Shana'a	J6638(C)	3577

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UNILEVER  
PATENT DEPARTMENT  
45 RIVER ROAD  
EDGEWATER, NJ 07020

EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/930,320

Applicant(s)

SHANA'A ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 7
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted January 14, 2003 is acknowledged.

#### *Claim Rejections 35 U.S.C. 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 26 recites the limitation "said angle" in line 1. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 27 and 28 define the viscosity in a range and at "25 C". It is not clear what the meaning of "25 C"

#### *Claim Rejections 35 U.S.C. 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 13-22, and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322, of record), in view of Rigg et al. (US 5,622,692, of record) and Stewart (WO98/30189).

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7. Rath teaches a method for providing customized cosmetic product. The method comprising preparing the cosmetic product by combining separate components that are selected by the customer. (see the abstract.) The separate components include a base composition, and some variable ingredients, such as thickener, enhancing additive. See, particularly, col. 4, line 17-56, col. 6, line 29 to col. 7, line 2, col. 8, lines 23-42 (thickening agents); and col. 5, lines 4-24, col. 7, lines 31-47, and col. 9, line 14 to col. 10, line 37 (enhancing additives). Each of the separated components may contain a preservative, a polyhydric alcohol or a fragrance. (col. 12, lines 43-47). The separate components are combined and mixed to obtain a homogeneous mixture (col. 13, lines 52-63).

8. For a composition containing a solvent, a solubilizing agent and a preservative, see the conditioner base disclosed at col. 5, line 44 to col. 6, line 8. For polyethylene glycol ethers of fatty alcohols and polysorbates as solubilizing agents see col. 5, lines 60-67. For the viscosity of the base compositions within the instantly claimed viscosity ranges see col. 3, lines 3-4, col. 5, lines 36-37, and col. 7, lines 58-59. For DMDM hydration and polyaminocarboxylic acid chelates (EDTA), see col. 13, lines 45-58, 66-67, Examples 9, 13, 14 and tables 16-21 at col. 17-23. The final composition may be prepared at a hair salon (a retail location) see col. 2, lines 34-36. The composition is packaged in containers (col. 13, lines 31-34). Rath also teaches various composition containing performance agents in varying amounts. See, col. 4, lines 28-30 and col. 9, line 26 to col. 13, line 5. Varying the amounts of the active agents is considered equivalent to provide a plurality of intensity levels as herein claimed. Several addition types of performance agents are disclosed. See, particularly,

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9. Rath does not teach expressly that the vehicles of each performance have at least two or three ingredients in common, a blank composition, a label identifying the components of the formulation, that the fragrance contain a solvent and at least one preservative in common, a label with code, a machine scannable bar code, the volume of the container, or the angle of the container' major axis during agitation.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the same vehicles (such as solvent, preservative etc.) for each of the performance agents (e.g., thickener, fragrance), since Rath teaches that each of the composition may contain the same components such as water, alcohols and preservatives.

Further, Rigg et al. teaches providing a customized cosmetic composition in a container having a bar code label for identifying the customized composition. See, particularly, col. 2, lines 55-67, col. 4, lines 16-63. Stewart teaches a system and a method of preparing a customized, point-of-sale cosmetic composition. The method provide a base composition, and at least one of additives, each additive comprise plurality of variants. Commonly used additives include pH adjusters, oils, drying agents, anti-dandruff agents, salts colors, fragrances moisturizers, gloss agents, etc. See, particularly, the abstract, pages 22-25 and the claims.

It is within the skill of artisan add an inert solvent or diluents to a cosmetic composition to dilute the composition in order to achieve the desired strength or level of activity of the composition. Therefore, absent evidence of unexpected results, the addition of a blank composition having common ingredients with the performance agents is not considered critical. The volume of the container is not considered critical to the invention absent evidence to the

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contrary because it is within the skill of the artisan to select a container capable of holding an appropriate amount of composition. It is within the skill of artisan to adjust the angle of container during agitation to achieve the desired mixing, absent evidence to the contrary.

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of Rath using similar vehicle in a container with a bar code label as taught by Rigg et al. with the reasonable expectation of obtaining compatibility of the separate components for specialized treatment composition that can be identified for future use. It also would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to employ more than one variable performance agents, including fragrance, colors, or benefit agents such as vitamins, antidandruff agent, in a customized composition as suggested by Stewart.

Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rath et al. (US 5,972,322, of record), in view of Rigg et al. (US 5,622,692, of record) and Stewart (WO98/30189), and in further view of Tartaglione (US 4,851,062, of record).

Rath et al., Rigg et al. and Stewart teaches or suggests all the limitation of the claims as stated above. They do not teach expressly a container with a neck, a plug inserted in the neck and a cap, or container with a neck and a cap without an orifice.

However, Tartaglione teaches a container for packaging cosmetic composition that has a neck and a cap wherein the neck may be closed with a plug. See the abstract, column 1, lines 10-14, column 3, lines 39-41, 50-65 and column 4, lines 30-35.

Therefore it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to provide the composition as suggested by Rath et al., Rigg et al.

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and Stewart in a container with a plug and a cap as taught by Tartaglione expecting to provide cosmetic composition in containers with safety closure for preventing contamination of the contents.

***Response to the Arguments***

Applicants' amendments and arguments submitted January 14, 2003 have been fully considered, they are persuasive in overcome the rejection under 35 U.S.C. 112 set forth in the prior office action, but are not persuasive with respect to the rejection set forth above for reasons discussed below.

10. Applicants argue that Rath teaches that the thickener in instant claims may, where appropriate, already added to the base composition, which is differ from the teaching of Rath, add assert that Rath is teaching away from the instant invention. These arguments are improper. Particularly, the instant claims do not exclude thickener as the performance agent. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Applicants allege that all of the components disclosed by Rath are central to the formulation of a useful product, and the components to be combined are quite different. This is incorrect. Applicants' attention is directed to col. 21-23, wherein color concentrates are disclosed. The ingredients of the color concentrates are essentially the same except the dyes. Also for the herbal additives, (examples 13 and 14) there are several ingredients are presented in all the herbal additives. There are obvious to one of ordinary skill in the art to add all the disclosed color concentrate in one cosmetic composition.

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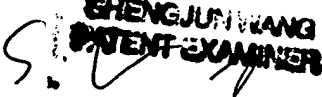
12. Applicants argue that Rath discloses a kit for customer, and it is a person other than the customer to determine the content of the kit, this is in contrast to the invention wherein customer selects the components. These arguments are not persuasive. First, Rath does not limit his system or method to kit. See the claims. Further the kit may contain various additives such as color concentrate of herbal additives for combination as desired by the customers. See the abstract, and col. 13, lines 31-43. As suggested by the title and the abstract, the system or method of Rath is for customers to combine necessary ingredients as desired by customer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner

 **SHENGJUN WANG**  
**PATENT EXAMINER**

Shengjun Wang

March 29, 2003



## Interview Summary

Application No.

09/930,320

Applicant(s)

SHANA'A ET AL.

Examiner

Alysia Berman

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All participants (applicant, applicant's representative, PTO personnel):

(1) Alysia Berman.

(3) \_\_\_\_\_.

(2) Allen Bornstein.

(4) \_\_\_\_\_.

Date of Interview: 27 November 2002.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: As of record.

Identification of prior art discussed: US 5,972,322.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

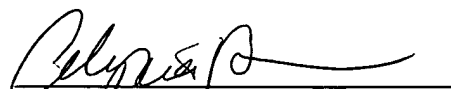
Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

##### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

##### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant will amend claim 1 to refer to a method to overcome the 35 U.S.C. 112/2nd paragraph rejection. The 35 U.S.C. 112/2nd paragraph rejection of claims 12-14 was discussed in view of the definition of benefits agents at pages 6-7 of the specification. Applicant will consider amending claim 1 to recite a Markush group of performance agents. The enhancement agents and multi-part kit disclosed by US '322 and prior art status of WO 01/58238 under 35 U.S.C. 102(e) were discussed..